

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 5, 2006. Reconsideration and allowance of the Application and pending claims 105-106, 108-115, and 122-139 are respectfully requested.

I. Interview Summary

Applicants first wish to express their sincere appreciation for the time that Examiner Bui spent with Applicants' Representative, Minh Nguyen, during telephone discussions on October 19 and 24, 2006, regarding the outstanding non-final Office Action. The discussions involve claim 105, the cited references, and the outstanding non-final Office Action. In particular, Applicants' Representative pointed out that *LaRocca* discloses a system and method that is related to subscription-on-demand services, not advertisements as recited in claim 105. An agreement was not reached during the discussions.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 105-106, 108-115, and 122-139 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ellis et al.* ("Ellis," U.S. Pat. No. 6,898,762 B2) in view of *LaRocca et al.* ("*LaRocca*," U.S. Pat. No. 6,314,572 B1). Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on Applicants' disclosure.

In the present case, it is respectfully submitted that the presently pending claims are allowable over the art of record.

Independent Claim 105

Claim 105 recites:

A method implemented by a television set-top terminal (STT) configured to provide television programs and a viewer's preference for advertisement categories, the method comprising:
receiving by a tuner in the STT at least one television program;

outputting to a television by the STT the at least one television program;

outputting to a television by the STT a graphical user interface (GUI) that comprises a menu having a plurality of viewer selectable advertisement categories, said plurality of viewer selectable advertisement categories including a first advertisement category and a second advertisement category that is different from the first advertisement category;

receiving by the STT a first viewer input corresponding to the first advertisement category and a second viewer input corresponding to the second advertisement category;

responsive to receiving the first and second viewer inputs, storing the first and second advertisement categories in the memory of the STT configured to store the viewer's preference for advertisement categories;

outputting to the television by the STT an advertisement based on the stored advertisement categories, wherein the advertisement is output by the STT at a future time during an interruption in the presentation of the at least one television program being output by the STT.

(Emphasis Added)

The Office Action stated that *Ellis* does not disclose “a menu having a plurality of viewer selectable advertisement categories”. (Page 4 of the Office Action). In this regard, the Office Action uses *LaRocca* to remedy this deficiency. Applicants respectfully submit that *LaRocca* also fails to disclose, teach, or suggest “a menu having a plurality of viewer selectable advertisement categories” as recited in claim 105, among others.

The Manual of Patent Examining Procedure (MPEP), Section 2141, provides that when “applying 35 U.S.C. 103, the following tenets of patent law must be adhered to...(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” The Office

Action alleged that *LaRocca* discloses a menu as recited in claim 105. The Office Action cited column 10, lines 30-44 of *LaRocca*, which is as follows:

“Fig. 5 depicts an exemplary category display 500 for a children's program subscription, e.g., OnSet Kids. The depicted menu 500 shows a list 502 of selectable categories. Each category in the list 502 represents a particular class of programming, i.e., programming that is related in some way.

At step 332, the subscriber selects a category within the category menu and, at step 334, the terminal sends a category request to the video session manager. After receiving a category selection in step 336, the video session manager sends an applet for a title menu to the terminal. At step 338, the terminal decodes and executes the applet to display a title menu. FIG. 6 depicts an exemplary menu list 600 having a list of titles that are associated with the selected category, in this case, Sesame Street.”

Applicants respectfully assert that the categories mentioned in the above quote correspond to subscription-on-demand (SOD) services, not advertisements as recited in claim 105. In addition, *LaRocca* states in column 10, lines 2-28 entitled, “Field of the Invention,” as follows:

“The present invention relates to an interactive information distribution system such as a video-on-demand (VOD) system. More particularly, the present invention relates to a method and apparatus for providing subscription-on-demand (SOD) services dependent subscription services and contingent services for such an interactive information distribution system.”

(Emphasis Added)

Applicants respectfully submit that *LaRocca* discloses a system and method that is related to subscription-on-demand services, not advertisements as recited in claim 105.

Accordingly, Applicants respectfully submit that claim 105 is patentable over *Ellis* in view of *LaRocca*, and respectfully request allowance of claim 105.

Because independent claim 105 is allowable over *Ellis* in view of *LaRocca*, dependent claims 106, 108-115, and 134-135 are allowable as a matter of law for at least the reason that the dependent claims 106, 108-115, and 134-135 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 122

Claim 122 recites:

A television set-top terminal (STT) system , comprising:

STT logic configured to output to a television a graphical user interface (GUI) that comprises a menu having a plurality of selectable advertisement categories, receive a plurality of viewer inputs respectively corresponding to selections made from the menu having the plurality of selectable advertisement categories, responsive to receiving the plurality of viewer inputs, store in a memory of the STT the viewer-selected advertisement categories, and after receiving the plurality of viewer inputs, receive advertisement data components corresponding exclusively to respective advertisements corresponding to the viewer selected advertisement categories.

(Emphasis Added)

For similar reasons presented above in relation to claim 105, Applicants respectfully submit that *Ellis* in view of *LaRocca* fails to disclose, teach, or suggest at least the above-emphasized claim features. Accordingly, Applicants respectfully submit that claim 122 is patentable over *Ellis* in view of *LaRocca*, and respectfully request allowance of claim 122.

Because independent claim 122 is allowable over *Ellis* in view of *LaRocca*, dependent claims 123-127 and 136-137 are allowable as a matter of law.

Independent Claim 128

Claim 128 recites:

A method implemented by a television set-top terminal (STT), comprising:
outputting to a television by the STT a graphical user interface (GUI) that comprises a menu having a plurality of viewer-selectable advertisement categories;
receiving by the STT a plurality of viewer inputs respectively corresponding to viewer-selected advertisement categories from the plurality of selectable advertisement categories, wherein the viewer inputs are provided by a viewer of the television; and
responsive to receiving the plurality of viewer inputs, outputting to the television by the STT a plurality of commercials respectively corresponding to at least one of the viewer-selected advertisement categories.

(Emphasis Added)

For similar reasons presented above in relation to claim 105, Applicants respectfully submit that *Ellis* in view of *LaRocca* fails to disclose, teach, or suggest at least the above-emphasized claim features.

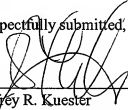
Additionally, Applicants respectfully submit that *Ellis* in view of *LaRocca* does not disclose, teach, or suggest *responsive to receiving the plurality of viewer inputs, outputting to the television by the STT a plurality of commercials*. Accordingly, Applicants respectfully submit that claim 128 is patentable over *Ellis* in view of *LaRocca*, and respectfully request allowance of claim 128.

Because independent claim 128 is allowable over *Ellis* in view of *LaRocca*, dependent claims 129-133 and 138-139 are allowable as a matter of law.

CONCLUSION

Applicants respectfully submit that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present Application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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